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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,496	01/09/2002	Gary J. Cross	AUS920011010US1	6742
35525	7590	09/20/2005	EXAMINER	
IBM CORP (YA)			SMITHERS, MATTHEW	
C/O YEE & ASSOCIATES PC				
P.O. BOX 802333			ART UNIT	PAPER NUMBER
DALLAS, TX 75380			2137	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

<b>Application No.</b> 10/042,496	<b>Applicant(s)</b> CROSS, GARY J.
<b>Examiner</b> Matthew B. Smithers	<b>Art Unit</b> 2137

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### **Status**

- 1) Responsive to communication(s) filed on 09 January 2002.
- 2a) This action is **FINAL**.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### **Disposition of Claims**

- 4) Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-30 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 March 2002 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### **Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   |   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/5/02; 5/23/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)               |
|  | 6) <input type="checkbox"/> Other: _____.   |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statements filed March 5, 2002 and May 23, 2005 have been considered as to the merits.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite a computer program product comprising steps implemented on a data processing system using instruction means to cause the data processing system to form a secure cellular telephone transmission system. However, the computer program product is not limited to a tangible embodiment. In view of Applicant's disclosure, specification page 15, line 16 to page 16, line 2, the instruction means, which are a part of the computer program product, are provided in a computer readable medium, which is not limited to tangible embodiments, but instead are defined as including both tangible embodiments (e.g., a recordable-type media) and intangible embodiments (e.g., transmission-type media). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

To overcome this type of 101 rejection the claims need to be amended to include only the physical computer media and not a transmission media or other intangible or non-functional media.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of copending Application No. 10/042,505. Although the conflicting claims are not identical, they are not patentably distinct from each other because the transmission medium used in each invention does not affect the secured transmission between the first computing device and the second computing device. In both inventions, the first and second computing units perform the encrypting/decrypting operations and the recording/playback of the signal transmitted over the communications medium. The conventional radio and conventional cellular devices function as transceivers for the

computing devices by passing the encrypted/recorded signal from one point to another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 5,815,553 granted to Baugh et al. and further in view of U.S. patent 5,915,021 granted to Herlin et al.

Regarding claim 1, Baugh discloses a method of providing a computer system with an input signal from a microphone (see Abstract; column 2, lines 58-62 and Figure 1, elements 50, 58 and 62); encrypting the input signal (column 8, lines 44-47); and transmitting the encrypted input signal to another destination using a communication medium (see column 3, lines 9-14 and Figure 11, elements 70 and 74). Baugh fails to specifically state the input signal is encrypted using public key techniques. Herlin discloses a method for sending a secure message in a telecommunications system using public key encryption (see column 5, lines 12-35 and column 9, lines 56-58 (. . . telecommunication equipment capable of encrypting and decrypting messages received

over phone lines . . .). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Baugh's apparatus for transmitting encrypted recorded messages with Herlin's system for secure communications in a telecommunications system to gain the advantage of securing the recorded message from unauthorized disclosure by an eavesdropper who is monitoring the communication link. By using public key encryption, the recorded message can only be decrypted by the private key that corresponds to the public key used to encrypt the message [see Herlin; column 3, lines 60-67].

Regarding claim 2, Baugh as modified discloses encrypting within a computer system an input signal using key pair (public key techniques) (see Baugh, column 8, lines 44-47 and Herlin, column 9, lines 56-58 (. . . telecommunication equipment capable of encrypting and decrypting messages received over phone lines . . .)

Regarding claim 3, Baugh as modified discloses encrypting within a computer system an input signal using public key techniques (see Baugh, column 8, lines 44-47; and Herlin, column 9, lines 56-58 (. . . telecommunication equipment capable of encrypting and decrypting messages received over phone lines . . .)

Regarding claim 4, Baugh as modified discloses receiving the input signal through a recorder that includes a microphone and associated software, encrypting the input signal and passing the signal through the communications medium (see Baugh, column 2, lines 58-62; Figure 1, elements 50, 58 and 62; column 3, lines 9-14; Figure 11, elements 70 and 74; and column 8, lines 44-47; and Herlin, column 9, lines 56-58 (.

. . telecommunication equipment capable of encrypting and decrypting messages received over phone lines . . .)

Regarding claim 5, Baugh as modified discloses a cellular phone with a microphone port (see Herlin, column 7, lines 31-33).

Regarding claim 6, Baugh as modified discloses using a second computer system with speakers and a playback device that allows a second user to hear the recorded message after it has been decrypted (see Baugh; Abstract; column 2, lines 58-62 and Figure 1, elements 50, 58 and 62; and Herlin, column 9, lines 56-58 (. . . telecommunication equipment capable of encrypting and decrypting messages received over phone lines . . .)

Regarding claim 7, Baugh as modified discloses encrypting within a computer system an input signal using key pair (public key techniques) (see Baugh, column 8, lines 44-47 and Herlin, column 9, lines 56-58 (. . . telecommunication equipment capable of encrypting and decrypting messages received over phone lines . . .)

Regarding claim 8, Baugh as modified discloses encrypting within a computer system an input signal using public key techniques (see Baugh, column 8, lines 44-47; and Herlin, column 9, lines 56-58 (. . . telecommunication equipment capable of encrypting and decrypting messages received over phone lines . . .)

Regarding claim 9, Baugh as modified discloses obtaining, by said second computer system, said private key of said computer and decrypting the encrypted input signal (see Baugh, column 2, lines 58-62; Figure 1, elements 50, 58 and 62; column 3, lines 9-14; Figure 11, elements 70 and 74; and column 8, lines 44-47; and Herlin,

column 9, lines 56-58 (. . . telecommunication equipment capable of encrypting and decrypting messages received over phone lines . . .)

Regarding claim 10, Baugh as modified discloses exchanging said private key between said computer system and said second computer system prior to transmissions of cellular telephone signals (see Herlin, column 5, lines 31-33).

Claims 11, 12, 13, 14, 15, 16, 17, 18, 19 and 20 are system claim that are substantially equivalent to method claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, respectively. Therefore claims 11, 12, 13, 14, 15, 16, 17, 18, 19 and 20 are rejected by a similar rationale.

Claims 21, 22, 23, 24, 25, 26, 27, 28, 29 and 30 are computer program product claim that are substantially equivalent to method claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, respectively. Therefore claims 21, 22, 23, 24, 25, 26, 27, 28, 29 and 30 are rejected by a similar rationale.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

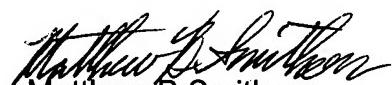
A. Luo (US 5,909,491) discloses a secure method for sending messages in a telecommunications system where the mobile phone performs the encryption/decryption operations on the messages.

B. Walter et al. (US 6,151,677) discloses a secure communications system where the mobile unit has a security module within that performs the encryption/decryption operations on the messages.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew B. Smithers whose telephone number is (571) 272-3876. The examiner can normally be reached on Monday-Friday (8:00-4:30) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel L. Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew B Smithers  
Primary Examiner  
Art Unit 2137